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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,608	05/02/2006	Hiroshi Hamasaka	92478-6200	6068

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EXAMINER	
HARVEY, DAVID E	
ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/549,608	HAMASAKA ET AL.	
	Examiner	Art Unit	
	DAVID E. HARVEY	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5 and 7-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 7-14* is/are rejected.

7)☒ Claim(s) *3-5* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 September 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/20/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

a) The "***machine-readable medium***" that "***provides instructions***" which are "***executed by a machine***" as recited in lines 1-2 of claim 8. .

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter**.

A) With respect to claim 8, the following is noted:

Claim 8 is directed to a "***machine-readable medium***" that "***provides instructions***" which are "***executed by a machine***". The notes that a fair reading of the "***machine-readable medium***" recitation encompasses "transitory" mediums which are non-statutory under section 101; i.e., such mediums are not a process, a machine, a manufacture, or a composition of matter, as required under Section 101. As such claim 8 is rejected as being directed to non-statutory subject matter.

5. Claim 9 is objected to because of the following informalities:

A) In lines 6 of claim 9, "sotored" should read –stored–.

Appropriate correction is required.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> **A person shall be entitled to a patent unless –**
>
> **(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

7. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,912,710 to Fujimoto.

As shown in Figure 1, Fujimoto discloses a reproduction apparatus in which stored graphics information is converted from a first resolution to a display resolution (e.g., @ 106) based on the detected resolution of the stored graphic information and the detected display resolution (i.e., aspect ratio) of the display apparatus [e.g., note lines 30-46 of column 7]. The system comprises:

A) A reading unit [e.g., including element 101 and elements for making said determination (note shown)]

B) A converting unit [e.g., including element 106];

C) An output apparatus [e.g., including element 109]; and

D) A display apparatus [e.g., @ 200]

8. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,912,710 to Fujimoto for the same reasons that were set forth above for claim 9. Additionally:

The examiner maintains that the "graphics data", as described in the context of Fujimoto, is inclusive of data representing "character fonts" [note window 23 of Figures 2 and 3].

9. **Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,912,710 to Fujimoto for the same reasons that were set forth above for claim 9.**

10. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,912,710 to Fujimoto for the same reasons that were set forth above for claim 11. Additionally:

The examiner maintains that the "graphics data", as described in the context of Fujimoto, is inclusive of data representing "character fonts" [note window 23 of Figures 2 and 3].

11. **Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,912,710 to Fujimoto for the same reasons that were set forth above for claim 12. Additionally:**

e.g., note lines 9-16 of column 14.

12. **Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #5,912,710 to Fujimoto for the same reasons that were set forth above for claim 12. Additionally:**

The examiner notes that Fujimoto does not explicitly state that the two resolution indicating inputs to element 106 are provided from respective memory units; i.e., corresponding the recited first and second memory unit of claim 14. The examiner maintains that such memory units, i.e., buffer memories, are inherently required because the data provided at the illustrated inputs would be instantly lost if not held/latched by some type of "memory unit" making the system inoperative. Clearly, some type of buffer/latch must inherently be present. The examiner notes that the "consideration of the relationship between" description in lines 35-45 of column 7 is indicative of a "comparing" process.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Document #2003/0188312 to Bae et al in view of one of US Patent Document #2003/02193233 to Kimura and US Patent #5,907,659 to Yamauchi et al.

A) The showing of Bae et al.:

As shown in Figures 2-4, Bae et al discloses a DVD playback device that comprises:

1) A DVD ***storage medium*** (e.g., @ 10 of Figure 2) having video data streams and related auxiliary data streams (e.g., subtitle data streams) stored thereon;

2) A ***first display unit*** (e.g., @ 22 of Figures 2 and 3) for displaying the identified type of related auxiliary data streams (e.g., a subtitle stream pertaining to a desired language) from the ***storage medium*** when the identified type is available from the storage medium; and

3) A ***second display unit*** (e.g., @ 22 of Figures 2 and 3 wherein element 40 of Figure 3 includes the server structure of Figure 4) for displaying and identified type of related auxiliary data streams (e.g., a subtitle stream pertaining to a desired language) from the ***server*** (@ 35 of Figure 4) when the identified type is not available from the storage medium.

B) Differences:

Claim 1 differs from the showing of Bae et al only in that in Bae et al the determination as to whether the locally stored auxiliary data is outputted to the display apparatus or whether the auxiliary data from the server is outputted to the display apparatus is made based on the local availability of the identified "language" of auxiliary data; i.e., as opposed to being made based on an identified display resolution (e.g., aspect ration).

C) Obviousness:

Kimura (note paragraph 0021) and Yamauchi et al (note: lines 28-32 of column 33; lines 50-52 of column 35; and lines 28-35 of column 36) each evidence the fact that it was known to have selected the type of auxiliary data stream based on the identified aspect ratio type; i.e., in addition to the identified language type. In light of the respective showings of Kimura and Yamauchi et al, it would have been obvious to one of ordinary skill in the art to have provided additional auxiliary data streams pertaining to different displayable resolution types (i.e., aspect ratios) in addition to the different language types; i.e., wherein the modification would have advantageously permitted the system to have worked with a wider range of displays and/or display modes.

Here it is noted that the recited ratio "1:1" simply appears to be an indication as to whether the resolution of the video is the same (i.e., 1:1 correspondence) with the display resolution (i.e., such a relationship being obvious, if not inherent, in the modified system).

15. Claim 2, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Document #2003/0188312 to Bae et al in view of one of US Patent Document #2003/02193233 to Kimura and US Patent #5,907,659 to Yamauchi et al.

16. The following references have been cited as being illustrative of the variable aspect ratio display art:

A) US Patent #7,106,383;

B) US Patent #6,707,504;

C) US Patent Document #2006/00115813;

D) US Patent Document #2005/0084246;

E) US Patent #6,714,254; and

F) US Patent #6,275,267.

17. Claims 3-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

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